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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/973,893 | 01/08/2002 | John C. Peiffer | 212722.00005 | 8949 |

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| EXAMINER |
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SAUNDERS JR, JOSEPH

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| ART UNIT | PAPER NUMBER |
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2615

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01/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 09/973,893 | Applicant(s) PEIFFER ET AL. | |
| | Examiner Joseph Saunders | Art Unit 2615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 83-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 83-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :9-2-03, 9-24-03, 3-25-04, 8-25-04.

DETAILED ACTION

1. This office action is in response to the preliminary amendment filed August 23, 2004. Claims 1 – 82 have been canceled claims 83 - 86 are currently pending and considered below.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 83 and 86 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 18, 19, 34, 35, 50, 57, 65, and 69 of copending Application No. 11/237,251. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Regarding claim 83, Application No. 11/237,251 discloses a method of inserting data in a compressed data bitstream, comprising: shifting ("time shifting") first data in a first portion of the compressed data bitstream to increase a size of a second portion of the compressed data bitstream; and inserting second data in the second portion of the compressed data bitstream to form a modified compressed data bitstream (see claims 1). It would have been obvious to one of ordinary skill in the art at the time of the invention that since a bitstream is a sequential ordering "shifting" is the same as "time shifting". Claims 18, 34, 50, 57, 65, and 69 also disclose the method and therefore also anticipate claim 83.

Regarding claim 86, Application No. 11/237,251 also discloses wherein shifting the first data in the first portion of the compressed data bitstream ^{includes} repacking ~~includes~~ ("moving") bits within the compressed data bitstream. It would have been obvious to one of ordinary skill in the art at the time of the invention that "repacking" would be synonymous with rearranging and therefore the equivalent to "moving" data within a compressed bitstream. Claims 2, 19, and 35 also disclose also disclose the method and therefore also anticipate claim 86.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 83 – 86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 83 – 86 recite the limitation of “shifting” however after consulting the specification paragraph 35 describes that “by appropriately modifying the SKIPL values at the end of each block and repacking the bits, a desired amount of space can be created” but does not disclose how this pertains to “shifting” data.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 86 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims wherein “shifting” includes “repacking” however shifting implies, since data within a bitstream is sequentially ordered, that data moves in one direction or the other within the bitstream and stills maintains it’s ordering whereas “repacking” implies that bits are rearranged and therefore “shifting” as presented in the sense of a bitstream cannot include “repacking”.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 83 – 86 are rejected under 35 U.S.C. 102(e) as being anticipated by Truman et al. (US 6,807,528 B1), hereinafter Truman.

Claim 83: Truman discloses a method of inserting data in a compressed data bitstream (Adding Data to a Compressed Data Frame), comprising: shifting first data (skip field and mantissa data) in a first portion of the compressed data bitstream (audio blocks) to increase a size of a second portion of the compressed data bitstream (aux field); and inserting second data (aux data) in the second portion of the compressed data bitstream to form a modified compressed data bitstream (Abstract and Column 4 Line 47 – Column 5 Line 31).

Claim 84: Truman discloses a method as defined in claim 83, further comprising examining a frame within the compressed data bitstream to determine a number of skip bytes within the frame (indicated by a “one-bit word” and a “9-bit word” and determined by the 5/8 and 3/8 configuration rules, Column 4 Line 47 – Column 5 Line 8).

Claim 85: Truman discloses a method as defined in claim 84, wherein shifting the first data in the first portion of the compressed data bitstream includes shifting the first data based on the number of skip bytes within the frame (Column 4 Line 47 – Column 5 Line 13).

Claim 86: Truman discloses a method as defined in claim 83, wherein shifting the first data in the first portion of the compressed data bitstream includes repacking bits within the compressed data bitstream (Column 4 Line 47 – Column 5 Line 31).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Saunders whose telephone number is (571) 270-1063. The examiner can normally be reached on Monday - Thursday, 9:00 a.m. - 4:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JS
January 3, 2008



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SUPERVISORY PATENT EXAMINER